

REMARKS

Claims 1-38 are pending in this application. By this amendment, Applicant has canceled claim 13 without prejudice or disclaimer and has amended claims 1, 3, 5, 6, 8, 9, 11, 14, 15, 18, 21-27 and 29-38. Applicant respectfully submits that the foregoing amendments are non-narrowing.

Reconsideration of the above-identified application in view of the foregoing amendments and the following remarks is respectfully requested.

Rejections Under 35 U.S.C. §103:

Claims 1, 3, 11, 13, 18, 19, 21, 22 and 24-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dan. Claims 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dan in view of Hines et al. Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Dan in view of Bell. Claims 4, 7, 14, 15, 20, 23 and 34-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dan in view of Yu et al. Claims 8 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dan in view of Hines et al. Claims 1, 11, 24, 29 and 35-38 are drafted in independent form.

The outstanding Office Action, in the section entitled “Response to Remarks”, provides:

“With reference to claim 1, the applicant has amended the claim to include the phrase, ‘wherein the image data is transmitted in one or more headers of one or more of the plurality of packets of the ongoing packet transfer.’

The added limitation can be interpreted in many ways. One way to interpret the limitation is to consider the image data is inserted in a header whose protocol level is at 3 or lower. In such instance, the claim would no longer read on the prior art of record and, in most likelihood, based on additional searches the Office has conducted, the claim would not read on prior art of non-record.

However, the limitation maybe also interpreted in another way. One may view ‘one or more headers of one or more of the plurality of packets’ to

mean that ‘headers’ refers to headers of application level documents (e.g., headers of html). The application level headers would be assumed to be in the payload portion of the packets.

The Office is under the obligation to raise all potential issues, and therefore, selects the second interpretation.” (Office Action, p. 2)

The Office Action, in the section entitled “Overcoming Prior Art”, then concludes:

“If claims 1 were amended to eliminate the second of the two possible readings described above, it would overcome the prior art of record, and most likely prior art of non-record.” (Id. at p. 4)

Applicant has amended claim 1 in that regard. In particular, Applicant has amended the above-cited clause of claim 1 to read: “wherein at least one of the plurality of packets of the ongoing packet transfer comprises a header portion and a separate payload portion and said at least a portion of the image data is transmitted in the header portion.” Applicant respectfully submits that claim 1, as amended, is patentably distinguishable from Dan. In contrast with amended claim 1, “[t]he application level headers [in Dan] would be assumed to be in the payload portion of the packets.” (Office Action, p. 2)

Accordingly, Applicant respectfully submits that amended claim 1 is allowable over Dan for this reason alone.

Claim 1 also requires “transmitting, during an ongoing packet transfer operation in which packets of content are transferred between a sending device and a receiving device, image data in addition to said content ... for display on a display associated with the receiving device during said ongoing packet transfer”. (emphasis added) On the claimed feature of “transmitting ... image data in addition to said content”, the Office Action provides:

“[See Fig. 21 for image data in addition to said content, or see lines 20-29, column 17 for including ‘banner object’, which is picture in the header]

* * *

In Fig. 21, Dan does not show that the banner is in ‘addition to said content.’

It would have been obvious to one of ordinary skill in the art at the time of the invention to have web page content, so that the web page header information is sent ‘in addition’ to the webpage content.” (Office Action, pp. 5-6)

However, the images of Dan cited in the Office Action (e.g., “Image(fish)” in Fig. 21 or the “banner ad” in col. 17, lines 20-29 of Dan) are the actual content of the web page itself. With respect to the “banner ad”, in particular, Dan provides:

“Header and footer objects may, for example, enable a user to attach content to a header, a top portion of a web page and/or to a bottom portion of a web page. A header or object may include, for example, a banner ad object 210.” (Dan, col. 17, lines 24-28) (emphasis added)

Thus, the banner ad is not image data *in addition to* the content that is the subject of the ongoing data packet transfer operation, as required by claim 1. Instead, the banner ad and/or the picture of the fish in Dan *are* the content of the web page. Nor does the Office Action’s proposed addition of “web page content” to the teachings of Dan yield the claimed invention. (See, Office action, p. 6) Rather, any such modification of Dan would simply result in transmitting more web page content.

Accordingly, Applicant respectfully submits that claim 1 is allowable for this additional reason.

Claims 11, 24 and 29 contain the feature of “image data in addition to said content” found in claim 1. Claims 35-38 contain a similar feature. Accordingly, Applicant respectfully submits that these claims are allowable for at least the same reason as set forth above in urging the allowance of amended claim 1.

In addition, the Office Action maintains that claims 11, 24, 29 and 35-38 contain “significant issues” in view of “prior art of non-record” as follows:

“The methods and apparatuses which the claims define are related to the concept of splicing some image data into on-going file/data transfer. The Office’s problem with these claims is that, even if the claims were refined to overcome the primary reference currently cited, they would not be able to overcome other prior art of *non-record*. These prior art references belong to the following technological areas:

(1) video splicing, for the purpose of presenting advertising, from the server side, into ongoing video content transfer.

(2) encoding, in which a given image is embedded by padding the pixel bytes in other data being transmitted. For instance, suppose that one has 20 images. There are ways to reserve 1 byte per pixel and encode additional data into the reserved pixels, such that after 20 pages have been transmitted, another (hidden) image has been transmitted at the same time. This concept is, of course, related to encoding, encryption and security.

New claims 35-37 appear to rehash the limitations of claims 11, 24, and 29 and their dependent claims.

Overall, even if claims 11, 24 and 29, and the new claims 35-38 were made much more precise, by the virtue of inserting limitations that elaborate what ‘ongoing transfer’ refers to, and thus overcomes the cited rejection, they would still need to overcome *other* references from the above-mentioned technological arts. At the moment, the Office does not see how that can come about, unless more specific limitations that describe a technique for splicing data (in the manner similar to claims 1 has, but without any ambiguity) are incorporated into those claims.”

(Office Action, pp. 3-4)

Although Applicant appreciates the Office Action’s efforts to raise all possible issues with the foregoing claims, Applicant finds it impossible to respond to the Office Action’s comments regarding prior art of non-record in any meaningful way without a concrete example of such prior art in the form of one or more references made of record. For example, Applicant is unable to review the dates or specific teachings of any such alleged prior art relative to the

claimed invention. Even the comments in the Office Action regarding the prior art of non-record are open to interpretation. For example, what is meant by “there are ways to”? Is the discussion that follows of known prior art teachings?

Dependent Claims:

Dependent claims 18, 19, 22, 27, 28, 32 and 33 were rejected in both the instant Office Action and the immediately prior Office Action as being obvious over Dan on grounds that:

“It would have been obvious to one of ordinary skill in the art at the time of the invention to insert image and its associated display parameters in the banner (in Fig. 9) using tag of HTML, so that the displayed image fits in the page that displays the image.”

“It would have been obvious to one of ordinary skill in the art at the time of the invention to insert image and its associated display parameters in the banner (in Fig. 9) using tag of HTML, so that in lieu of text data, the image data is displayed.”

(Office Action, pp. 6-7)

In its response to the prior Office Action, Applicant requested that, should the Examiner persist in the foregoing rejections, he provide evidence in support thereof. In the instant Office Action, however, the rejections were repeated without any further elaboration. Evidence in support is again respectfully requested.

Applicant does not believe it necessary at this time to further address the rejections of the dependent claims as Applicant believes that the foregoing arguments and amendments place the independent claims in condition for allowance. Applicant, however, reserves the right to address those rejections in the future should such a response be deemed necessary and appropriate.


For the above-stated reasons, this application is respectfully asserted to be in condition for allowance, and an early and favorable examination on the merits is respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required by this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4208-4066. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4066. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Dated: July 6, 2006

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.
By: 
Peter N. Fill
Registration No. 38,876

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700 Telephone
(212) 415-8701 Facsimile